

REMARKS

Claims 1 to 6 are pending, and have all been rejected.

INTRODUCTION

Perhaps the best way to understand the claimed invention is to recognize that the cards have do not have non-descriptive backs, as ordinary cards have. This means that when they are first dealt, the player will always be provided information about the card, either the card's suit or its numerical value. There are no "face-down" cards, as in conventional cards. With this invention, after the player selects a card to add to his hand, then both attributes of the card, the suit and the numerical value, are visible. This is shown in Figure 1 where at first, when the card is dealt, only the suit of card 20 (clubs) is shown. When the player selects the card for his hand, both the value and suit of the card are revealed. In this case, card 20A is a King of clubs.

Applicant respectfully submits that no prior art card or game has this novel feature.

CLAIM 1

The Examiner has rejected claim 1 stating that it was anticipated by Stanton. In particular, the Examiner has cited lines 14-24 and Figures 1 to 4 of Stanton. For clarity, Applicant has reproduced those lines below because they do not have any bearing whatsoever on Applicant's invention:

"According to this invention, I arrange the complete set of cards *i.e.*, the four suits, into four sets each set having cards of equal value, and so mark, print, brand, denote or otherwise distinguish the four sets that, in dealing, each player will receive one of the sets of the cards. The distinguishing of the cards may be variously modified as desired, it may be done by printing the backs of the cards in different colours, by applying distinguishable advertisements, or by printing

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different designs, one on each set. In arranging say, an ordinary set or pack of playing cards each distinctive set will consist of the following cards, viz: Ace, ten six, and two (deuce) of one suit; king nine, and five of another suit; queen, eight and four of another suit, and knave [jack], seven and three of the last suit.”

Stanton states:

“the main object of the invention being to provide a pack or set of cards which can be dealt so that each player at the commencement of a hand or game will hold cards which are equal in value to the cards held by the other and respective players.” (Page 1, lines 4-7).

On page 2 of Stanton (The Complete Specification), he further explains his cards are intended to overcome a certain problem with conventional cards (lines 10 to 15):

“Under the present system the cards are shuffled and dealt indiscriminately and almost invariably the holder of the cards of the highest value succeeds in winning, irrespective of skill or ability.

According to this invention I arrange the complete pack of cards *i.e.*, the four suits, into four groups or sets of 13.

Each group or set having cards of equal value made up of different suits . . .”

Stanton’s cards were to be used in a game called whist, a game similar to bridge, where four players compete as two-sets of partners. Stanton observed that the winner of the game typically was the person who was dealt the best cards – not necessarily the best player. His solution was to start all four players on equal footing by giving them each the identical hands. That way, the game would turn exclusively on skill, and luck would be removed from the equation. Obviously, dealing a conventional deck to four players to insure each had the same starting hands would be laborious. To overcome that problem, Stanton developed his deck that used a color code or some distinctive card back to facilitate dealing. With his deck, each player would receive the

same hand, although with different suits, and apparently the players would not know which suits the other players had.

However, Stanton's cards are altogether different from Applicant's invention. Stanton's card's have a particular pattern on their back to enable the dealer to distribute identical hands to four players. Indeed, Stanton's cards have four patterns on the backs—none of which provides the player any information about the suit or value of the card. The important distinction here is that Applicant's cards always provide either the value or the suit and provide the player with critical information required to make a playing decision.

Moreover, Stanton did not separate the card value and suit and put one on the opposite side of a card, as explained in Applicant's invention. Stanton, therefore did not anticipate, nor do his cards suggest Applicant's invention.

CLAIMS 2-6

The Examiner stated that claims 2-6 would have been obvious in view of the published Hoyt application and Stanton combined.

Hoyt's discloses several unrelated things. One is a "Tic-Tac-Toe" card game using conventional cards where the cards are dealt in a 3 x 3 matrix. This configuration could be used to play blackjack or poker, but has nothing to do with Applicant's invention. Although the Examiner is correct that Hoyt describes a poker game, he does so in the context of conventional cards.

Hoyt's other embodiments use cards that have numerical values only – and no suits. In the embodiment of Figure 2, Hoyt has 60 cards divided into six groups made up of 10 cards each. (See page 3, paragraph “[0037]”).

Hoyt states:

“These cards do not necessarily need a suit indication (Club, Spade, Diamond or Heart) as found on cards from a standard playing deck of cards.” (See page 3 paragraph “[0037]”).

Indeed, claim 3, which covers this embodiment shows Hoyt's cards have conventional backs:

“3. A deck of playing cards comprising a multiple number of playing cards, each card having a front side of the card and a back side of the card, said back side either containing a design or not containing a design, such that each of the multiple number of cards contains a back side which is similar to each of the other multiple number of cards, such that said multiple number of cards cannot be distinguished from the others by observing the back side of the card, said front side of each of said multiple number of playing cards contains an indication of quantity, said indication of quantity being between one and ten.

Plainly, Hoyt's cards are not the same or remotely similar to Applicant's novel deck.

Hoyt's card in Figure 3 are modeled after a roulette wheel. (See paragraph “[0040]”). Cards are numbered from 1 to 36 with “0” or “00”. Each card, like a roulette wheel has the color red, black or green. (See Paragraph “[0040]”).

Claim 5, which covers this embodiment, again, makes it plain that Hoyt's cards have card backs:

“5. A deck of playing cards comprising a multiple number of playing cards, each card having a front side of the card and a back side of the card, said back side either containing a design or not containing a design, such that each of the multiple number of cards contains a back side which is similar to each of the other multiple number of cards, such that said multiple number of cards cannot be distinguished from the others by observing the back side of the card, said front

side of each of said multiple number of playing cards contains a number, an indication of color, an indication of odd or even, and an indication of group.

Both the claims and specification demonstrate that Hoyt's cards do not resemble Applicant's cards and do not suggest the method or games Applicant has claimed.

Assuming arguendo that there was some motivation to combine Stanton and Hoyt, and there is none¹, the combined cards would be an unusable mishmash of cards that were not at all the same as Applicant's cards or games. If, for example, these cards were combined, Stanton's conventional cards with a coded back and Hoyt's cards either numbers 1 to 10 or 1 to 36 (with "0" and "00"), the deck would have either 38, 52 or 60 cards of an unclear design. Would the cards have suits? Would they have coded backs? Would they have numbers 1 to 10 without suits, or would they be 52 cards with the suits and value on one side, as in conventional cards, and marked backs. In sum, the combined cards would not be Applicant's innovative design.

The Examiner has also stated that "[i]t would be obvious to deal cards in whatever shape that is desired since shape would constitute a design issue. Additionally,

¹ The Examiner's conclusion that it would have been obvious to combine these references is inconsistent with the MPEP § 2143.01:

"A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." (Second emphasis supplied; citations omitted).

Here, there is no "objective reason to combine the teaching of the references."

the dealing of cards in various shapes is well known in the art (e.g., *Memory* cards are dealt in the shape of a square, in the game of *Solitaire*, cards are ultimately dealt in the shape of a triangle.” Applicant is unfamiliar with “Memory” and “Solitaire” game where cards are in the shape of a triangle.²

Respectfully, Applicant’s diamond-shaped game is not purely a “design issue.” Rather, it is a novel arrangement of cards that permits multi-hand play, which is extremely popular, has common corner cards, permits players to exchange cards to improve their hands, is visually unique and should draw players in a crowded casino setting – and has a unique deck of cards never before used. No prior art game suggests this novel combination of features.

As explained in MPEP § 2141.02 Applicant’s invention must be considered as a whole:

"In determining whether the invention as a whole would have been obvious under 35 U.S.C. 103, we must first delineate the invention as a whole. In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question ... but also to those properties of the subject matter which are inherent in the subject matter *and* are disclosed in the specification. . . Just as we look to a chemical and its properties when we examine the obviousness of a composition of matter claim, it is this invention *as a whole*, and not some part of it, which must be obvious under 35 U.S.C. 103." (Citations omitted).

Applicant’s invention considered as a whole is drastically different from any cited prior art.

² “When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons. See 37 CFR 1.104(d)(2).” MPEP § 2144.03.

Moreover, if shape were merely a “design issue” many of the references the Examiner has cited (e.g., Moody and Hoyt) would not be patentable. Therefore, Applicant respectfully disagrees with the Examiner’s conclusion.

Indeed, the large number of prior art patents itself is testimony to the non-obviousness of Applicant’s inventions. Although playing cards have existed for centuries, (see a medieval set of cards www.metmuseum.org/collections/view1.asp?dep=7&full=1&item=1983%2E515%2E1%2D52), and dozens of patents exist related to cards and various card games, many of which have been cited by the Examiner, none is the same, similar or provides any motivation whatsoever to develop Applicant’s novel invention. Failure of others and long standing need are persuasive indicia of non-obviousness. See generally, WMS Gaming v. IGT, 184 F.3d 1339 (Fed. Cir. 1999).

Indeed, without some additional technology (e.g., a digital computer, or colored filter and lights) these novel cards would not have been impossible to use efficiently. This is because there is no way to have the cardbacks change appearance from hand to hand to provide suit or numerical value information as proposed by Applicant. To illustrate this consider the first hand where only the suit of the card would be displayed to the player as shown in Figure 1, element 20. If the player selects this card, then both the suit and value would be displayed as in element 20A. In the next hand, the numerical value of the same card (not the suit) could be shown, and if the player selects the card, then both the value and suit would be shown. Without digital computers or other sophisticated technology, this task would be all but impossible. Surely in 1912, when Stanton was published, Applicant’s cards would not have been feasible.

This obviousness rejection, therefore, is inapplicable.

* * *

None of the prior art references the Examiner has cited, including those listed as pertinent, discloses or suggests Applicant's invention. None of the references alone or in combination meets the limitations of the pending claims, or suggests the desirability of the claimed inventions.

AMENDED CLAIMS

Applicant has amended several claims, not to overcome the prior art, because as pointed out, none of the prior art comes close to suggesting the novel invention, but instead to clarify the claimed invention.

ADDED CLAIMS

Applicant has added claims to better cover the invention. As shown in Figure 1, when the suit is displayed a player is given an opportunity to hold that card. If he holds the card, it will be "turned over" to reveal both the suit and value of the card.

The additional claims do not require any additional searching.

INFORMATION DISCLOSURE

To comply with MPEP § 2001.06(b) and C.F.R. § 1.56, Applicants want to point out that they also have other co-pending applications related to card games: serial numbers 10/156,381, 10/015,314 and 10/211,063.

The prior art that has been submitted for the most part was cited by the Examiner in co-pending applications.

Applicant also expects to file very shortly a continuation application to claim additional games that can be played using these novel cards. This application will also be co-pending.

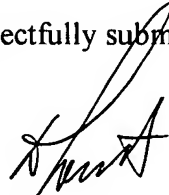
TELEPHONE DISCUSSION

Applicant would like to thank the Examiner for the courtesy of the telephone conversation on March 21, 2003. No substantive amendments were discussed.

CONCLUSION

For the foregoing reasons, Applicant believes his invention was neither anticipated nor was obvious in view of the cited prior art. Therefore, Applicant respectfully requests reconsideration of the claims, together with a favorable determination.

Respectfully submitted,

 4/8/03

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